

REMARKS

Claims 1-23 are pending in this application. By this Amendment, claims 15, 16 and 21 are amended. No new matter is added.

I. Double Patenting Rejection

Claims 1-23 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of co-pending US Application No. 09/683,326. Applicants concurrently file a Terminal Disclaimer and a Power of Attorney by Assignee in compliance with 37 C.F.R. §§1.321(c), thus overcoming this rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

II. Objections

Claims 15 and 21 are objected to for specific informalities. By this Amendment, claims 15 and 21 are amended to address these issues. Reconsideration and withdrawal of the objections are respectfully requested.

III. §103 Rejections

A. §103 Rejections Over '974 and '301

Claims 16-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,997,974 to Schlueter et al. ('974) in view of U.S. Patent No. 5,942,301 to Schlueter et al. ('301). Applicants respectfully traverse the rejection.

Independent claim 16 is directed to a seamless flexible electrostatographic imaging member belt fabrication method, and recites: "overlapping and mating the first and second desired features." Neither '974 nor '301 teaches or suggests at least this feature of claim 16.

As disclosed in Figs. 5 and 6 of the instant specification, and as explained at page 4 of the previous Amendment, claim 16 is directed towards lap joints (e.g., overlapping joints) as opposed to edge cutting (e.g., puzzle joints). In contrast to claim 16, '974 requires puzzle

joints whose mating elements have a gap between them to which adhesive material is applied. See '974 at the Abstract and col. 3, lines 40-54. In fact, '974 teaches away from the claimed invention by prohibiting overlapping joints. See '974 at column 1, lines 50-52 and 60-65. Thus, '974 does not teach or suggest "overlapping and mating the first and second desired features," as required by claim 16.

'301 does not overcome the deficiencies of '974, because '301 also does not teach or suggest "overlapping and mating the first and second desired features." In contrast to claim 16, '301 requires puzzle-cut interlocking mating elements having a gap between them. See '301 at column 1, lines 43-46, column 2, line 62, and Fig. 2. In fact, '301 teaches away from the claimed invention by disclosing that "the mating elements preferably are joined to result in a butt joint rather than for example an overlap joint to minimize the seam height." See '301 at column 3, lines 5-7. Thus, '301 does not teach or suggest, and in fact teaches away from, "overlapping and mating the first and second desired features," as required by claim 16.

Claims 17-20 depend from claim 16, and thus include all of its limitations. Accordingly, neither '974 nor '301 teaches or suggests every feature of these dependent claims for at least the same reason as claim 16.

For at least the reasons discussed above, claims 16-20 are patentable over '974, alone or in combination with '301. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

B. §103 Rejections Over '355 and '301

Claims 21 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,688,355 to Yu et al. ('355) in view of '301. Applicants respectfully traverse the rejection.

1. **'355 Cannot Be Combined With '301**

'355 discloses overlapping joints and coating of the substrate support sheet with an electrically-conductive surface material before producing the seamed belt. See '355 at the Abstract; col. 8, lines 23-38; col. 10, lines 19-23; and Examples 1-5. '355 requires overlapping joints and coating of the substrate before forming the seam, and is silent as to coating of the seamed belt. As discussed above, and in direct opposition to '355, '301 discloses puzzle-cut interlocking mating elements having a gap between them, and prohibits overlapping joints.

Modifying '355 based on the disclosure of '301 would require modifying '355 to have puzzle-cut joints as opposed to overlapping joints, and coating the seamed belt as opposed to coating the substrate before forming the seam. '355's intended purpose is a seamed flexible belt that exhibits greater resistance to tearing, fatigue delamination, fatigue-induced cracking and improved belt life, and requires overlapping joints and coating of the substrate before forming the seam to achieve this goal. Thus, modifying '355 based on the disclosure of '301 would destroy '355 for its intended purpose. MPEP §2143.01 states: "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Thus, in view of MPEP §2143.01, there is no motivation or suggestion for one skilled in the art to modify '355 based on '301.

In addition, although '301 discloses coating the seamed belt, the disclosure of '301 taken as a whole teaches away from '355. MPEP §2141.02 states: "A prior art reference must be considered in its entirety, i.e., as a whole, including portion that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Gardlock, Inc.*, 721 F.2d 1540, 220

USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." (Emphasis in original). In view of MPEP §2141.02, it is improper to focus only on '301's disclosure of coating the seamed belt, based solely on the teachings of the instant application, without considering '301's teaching of puzzle-cut interlocking mating elements having a gap between them. '301's disclosure of puzzle joints and of coating the seamed belt are both in direct opposition to '355. MPEP 2415 states: "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)." Accordingly, because '301 must be considered as a whole and because '301 teaches away from '355, it is improper to combine '355 and '301.

2. Claims 21 and 22 Are Patentable Over '355 and '301

Independent claim 21 is directed to a seamless flexible electrostatographic imaging member belt fabrication method, and recites: "overlapping the first and second desired features," and "applying at least one coating over the substrate support sheet, the at least one coating including a photoconductive coating." Neither '355 nor '301 independently teaches every feature of claim 21.

As discussed above, '355 does not teach or suggest the claimed coating of the seamed belt, and teaches away from the claimed invention by remaining silent as to requiring coating of the substrate support sheet before producing the seamed belt. As discussed above, '301 does not teach or suggest the claimed overlapping, and teaches away from the claimed invention by requiring puzzle joints and prohibiting overlapping joints. Thus, for at least the reasons discussed above, neither '355 nor '301 independently or combined teaches or suggests every feature of claim 21.

Claim 22 depends from claim 21, and thus includes all of its limitations. Accordingly, neither '355 nor '301 independently or combined teaches or suggests every feature of this dependent claim, for at least the same reasons as claim 21.

For at least the reasons discussed above, claims 21 and 22 are patentable over each of '355 and '301. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

C. §103 Rejections Over '974, '355 and '301

Claims 1-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over '974 in view of '355 and '301. Applicants respectfully traverse the rejection.

Claims 16-22, '974, '355 and '301 are discussed above. For at least the reasons discussed above, '974, alone or in combination with '301, fails to teach or suggest every feature of claims 16-22. In addition, for the reasons discussed above, '355 fails to teach or suggest every feature of claims 16-22. As discussed above, neither '974 nor '301 can be combined with '301 in an effort to achieve the claimed invention.

Independent claims 1 and 10 are each directed to seamless flexible electrostatographic imaging member belt fabrication methods, and each recites: "overlapping the first and second desired features," and "applying at least one coating over the seamed belt." '974, alone or in combination with '301, fails to teach or suggest every feature of claims 1 and 10. In addition, '355 fails to teach or suggest every feature of claims 1 and 10.

As discussed above, '974 requires puzzle joints whose mating elements have a gap between them to which adhesive material is applied, and prohibits overlapping joints, and '301 discloses puzzle-cut interlocking mating elements having a gap between them, and prohibits overlapping joints. As discussed above, '974, alone or in combination with '301, fails to teach or suggest "overlapping the first and second desired features," as required by

each of claims 1 and 10. As discussed above, '355 requires overlapping joints and coating of the substrate before forming the seam, and is silent as to coating of the seamed belt. As discussed above, '355 fails to teach or suggest "applying at least one coating over the seamed belt," as required by each of claims 1 and 10.

Claims 2-9 dependent from claim 1, and thus include all of its limitations. Claims 11-15 depend from claim 10, and thus include all of its limitations. Accordingly, '974, alone or in view of '301, fails to teach or suggest every feature of these dependent claims for at least the same reasons as claims 1 and 11. In addition, '355 fails to teach or suggest every feature of these dependent claims, for at least the same reasons as claims 1 and 11.


For at least these reasons, claims 1-23 are patentable over '974, alone or in view of '355 and '301. Reconsideration and withdrawal of the rejection of this claim are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-23 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:

Power of Attorney by Assignee w/Appendix
Terminal Disclaimer

Date: January 7, 2004

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